

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. Claim 1 is amended without prejudice or disclaimer.

Applicants thank the Examiner for the detailed response to our previous arguments. Applicants have made a minor amendment to the claims and shall address the Examiner's positions in the response.

Rejection of Claims 1, 3, 4, 6 and 18 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1, 3, 4, 6 and 18 under 35 U.S.C. §103(a) as being unpatentable over Cobbley et al. (U.S. Patent No. 5,818,510) ("Cobbley et al.") in view of Hooks et al. (U.S. Patent No. 6,169,542) ("Hooks et al.") and further in view of Dimitrova (U.S. Patent No. 6,363,380) ("Dimitrova"). Applicants respectfully traverse this rejection and submit that these references should not be combined especially in view of amendments made above.

First, Applicants shall present a new argument with regards to whether one of skill in the art would combine these references. Specifically, we first discuss Cobbley et al. and Hooks et al. The Office Action on page 6 notes that Hooks discloses a method of storing and delivering adds where the adds are presented chronologically separate from the program content. Various portions of Hooks et al. which are cited involve delivering content in a linear fashion on a display. For example, Figure 4 illustrates a set top box and a television 98 which is used to display the programming. Column 3, lines 33-47, cited in the Office Action, state that "interactive video programming can be contrasted with the more traditional full motion video, also referred to as linear programming, in which content sequences predetermine and does not vary in response to user input. Column 4, lines 54 - Column 5, line 3, also cited in the Office Action, discuss Figure 2 which shows a timing diagram which shows coordination between a full motion program and first and second advertisements which are inserted into the full motion

program 36 at a predetermined time period, such as during an advertising break 43. Applicants fundamentally note that while ads are presented chronologically separate from the program content, it is fundamental to the understanding of the invention of Hooks et al. that programs specific data be related to the first and second advertisements 40 and 42. These include identifiers for identifying the interactive advertisements such as the first and second advertisements 40 and 42. In other words, Applicants point is that the teachings of Hook et al. fundamentally involve the concept of presenting advertisements on a display as part of a full motion program and during advertisement breaks.

The Office Action on page 6 asserts that it would have been obvious for one of skill in the art to incorporate the teachings of Hook et al. into the system of Cobbley et al. to index, search, and present ads in an orderly manner to provide more effective delivery of ad in accordance to the preference of users. Applicants traverse this analysis because Cobbley et al. expressively teach away from such an approach. Applicants note that in the background section of Cobbley et al. they teach that a disadvantage of the current video and audio broadcast is that the end users are limited to either watching the information as it is received, or viewing it as recorded on a VCR. These methods force the users to consume the information sequentially in the order it is received. They explain that during a news broadcast, important headlines may be broadcast first, and weather reports may be broadcast sometime later. Applicants respectfully submit that the concept here of watching information as it is received is exactly what is taught in Hooks et al. For example, their timing program which presents advertisements that are inserted into the full motion program at a predetermined time period are exactly the feature and the arrangement with regards to advertisements that is expressively criticized in the background section of Cobbley et al. Applicants note that the concept of managing advertisements in the

advertisement break of a full motion program is fundamental to the invention of Hooks et al. For example, Column 6, lines 39-48, also cited in the Office Action, explain that

“A single advertisement break 43 having two advertisements is illustrated in Figure 2. However, those skilled in the art would recognize that more than two advertisements may be transmitted in connection with full-motion program 36 during advertisement break 43 and there may be more than one advertisement break 43 associated with full-motion program 36. These additional advertisement breaks are also represented by start and stop synchronization signals and the advertisements are signified with end-of-advertisement synchronization signals.”

Notably, this approach to presenting advertisements with the timing information is fundamental to the Hooks et al. invention which concept is expressively criticized in Cobbley et al.

Next, we note that the invention of Cobbley et al. fundamentally involves receiving secondary information that is displayed on display 210. In other words, Figure 2 illustrates window 210 which is a display for presenting the index information to the user which is separate from information display area 205 which is used to present news information for the primary program. See Column 11, lines 5-37. Therefore, Applicants respectfully submit that it is a fundamental principle of operation of Cobbley et al. to utilize the separate index display 210 which is separate from the information display area 205 and enables the purpose of Cobbley et al.'s invention. Namely, Cobbley et al. enables the user to view indexing information in window 210 so that they may select segments of the program for transmitting to the requested user. See Abstract. In this manner, the user can avoid watching the information as it is received. See Column 1, lines 29-31.

In other words, to utilize the teachings of Hook et al. in Cobbley et al. to index, search, and present ads in an orderly manner, would violate the fundamental purpose of Cobbley et al., which is to avoid watching information as it is received. Hook et al.'s invention involves presenting advertisements in advertisement breaks in full motion programs. Indeed, Hooks et al.

explain that managing these interactive advertisements with advertisements and identifiers in these advertising breaks is “of particular interest to the understanding of the present invention” and involves their program’s specific data related to the first and second advertisements 40 and 42. Thus, Applicants respectfully submit that if the mechanism of presenting ads in an orderly manner of Hooks et al. were incorporated into Cobbley et al., then the principle of operation of Cobbley et al. and its intended purpose would fundamentally be frustrated or destroyed because one would then return back to the criticized approach of “watching the information as it is received... these methods force the end users to consume the information sequentially in the order it is received.” Column 1, Lines 30-33. Therefore, Applicants respectfully submit that blending these references in the manner suggested in the Office Action would violate the principles of MPEP 2143.01 Sections V and VI. Here, the MPEP establishes that if blending the references would require a change in the principle of operation or change the principles of the prior art invention being modified away from its intended purpose, then there is not sufficient motivation or suggestion to combine the references. Applicants respectfully submit that this is exactly the legal analysis that applies here inasmuch as blending the references in the specific manner suggested in the Office Action would require actually changing Cobbley et al. away from its intended principle of operation and back to the criticized method of forcing end users to consume the information sequentially in the order it is received.

Furthermore, Applicants note that using the approach of Hooks et al. would also eliminate the need for utilizing the index display 210 of Cobbley et al., which again is fundamental to its principle of operation, and thus provides an additional reason why blending these references would change the intended purposes and teachings of Cobbley et al. Therefore, Applicants respectfully submit that these references should not be combined.

Applicants further note that claim 1 has been amended to require the television commercials to be presented chronologically separate from the program content and in a same display screen as the program content. Applicants note that this provides an expressed differentiator from Cobbley et al. inasmuch as Cobbley et al. require the index display 210 to present its "secondary information" which clearly differs from display 205 in which a news broadcast is presented. Therefore, Applicants submit that Cobbley et al. actually teach away from the concept of presenting television commercials chronologically separate from the program content and in a same display screen as the program content. Therefore, Applicants submit that this feature is not taught in Cobbley et al. and also applies to the argument above which prevents Cobbley et al. from being combined with Hook et al.

Therefore, Applicants respectfully submit that claim 1 is patentable and in condition of allowance.

Applicants further submit that dependent claim 3-7 are patentable and in condition of allowance.

Claim 18 is amended in a similar manner to claim 1, and therefore Applicants submit that claim 18 is patentable and in condition of allowance.

Rejection of Claims 5 and 7 Under 35 U.S.C. §103(a)

The Office Action rejects claims 5 and 7 under 35 U.S.C. §103(a) as being unpatentable over Cobbley et al. in view of Hooks et al. and further in view of Dimitrova and further in view of Hoffert et al. (U.S. Patent No. 5,983,176) ("Hoffert et al."). Applicants respectfully submit that dependant claims 5 and 7 are patentable and in condition for allowance inasmuch as their parent claims are patentable and Applicants reserve the right to further argue that Dimitrova and/or Hoffert et al. should not be combined with the two primary references.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

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